

Remarks

This amendment is submitted under 35 U.S.C. § 132 and 37 C.F.R. § 1.111 in response to the Office Action dated August 12, 2004, wherein claims 1 – 9 were rejected as being anticipated by U.S. Patent No. 3,474,503, to Less (hereinafter the “Less patent”), claims 10 – 12 were rejected as being obvious in view of the Less patent, and claims 13 – 14 were allowed. By this amendment, applicant has amended claims 4 and 8. Claims 1 – 14 remain pending. Reexamination and reconsideration of the application in view of the foregoing amendments and following remarks are respectfully requested.

Allowed Claims

Applicant appreciates the favorable consideration of claims 13 and 14, and has left those claims unchanged.

Claim Amendments

Claim 4 has been amended to place it in independent form by incorporating all of the limitations of claim 1, upon which it formerly depended. In addition, independent claim 8 has been amended to specify that the hook for engaging the necktie has a curvature that lies in a plane which intersects the plane defined by the flat elongate body. This feature of preferred embodiments of the present invention is neither shown nor suggested by the Less patent. It is noted that a “flat” object, as used in original claim 8, inherently defines a plane.

In rejecting original claim 4, the examiner stated that the Less patent shows, “a hook lying in a first plane that is generally orthogonal with respect to the second engagement mechanism as shown in figures 8 and 8A.” (Office Action page 2, paragraph 2.) Applicant notes that the Less patent does not contain a figure 8A. Therefore, applicant assumes that the examiner meant to refer to FIGS. 6 and 6A. However, FIGS. 6 and 6A do not show a hook which has a curvature which lies in a plane that is generally orthogonal to the plane defined by the first hook, as specified in claim 4, or that intersects the plane defined by the flat body of the holder, as specified in claim 8. FIGS. 6 and 6A shows a second hook (lower 42) which has a curvature that lies in a plane that is offset from, but *parallel* to the plane of the first hook (upper 42). The curvatures of these two hooks do not define orthogonal (*i.e.*, perpendicular) or intersecting planes. Nor is there any suggestion in the Less patent, or any motivation shown, for

modifying the any of the embodiments to have hooks which define intersecting or orthogonal planes. Unlike the present invention, the Less patent is not concerned with securing the knot of a necktie and, therefore, there is no reason to adapt the teachings of the patent to achieve the present invention. The Less patent is directed to solving a much different problem.

### Traversal of Rejections

Claim 1 was rejected as being anticipated by the Less patent. In making the rejection, the examiner has expressly ignored the functional requirements of claim 1. Specifically, claim 1 recites that the first engagement mechanism is, “for attaching the necktie holding apparatus to the collar button of a shirt”, and that the second engagement mechanism is, “for attaching the necktie holding apparatus to a knot formed in a necktie”. The examiner’s stated position is that this claim language “has not been given patentable weight since it does not positively limit the metes and bounds of the patent protection as desired.” Applicant respectfully submits that it was error for the examiner to ignore the functional language in claim 1.

MPEP § 2173.05(g) addresses the proper treatment of functional language in a claim. It says:

“There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971). ***A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step.***” (Emphasis added.)

Applicant respectfully submits that the MPEP and case law require that the functional language in claim 1, and in other claims of the application, must be considered for what it fairly conveys to a person of ordinary skill in the art. Here the second engagement mechanism of claim 1 must be capable of performing the function of attaching the necktie holding apparatus to the knot of the necktie. Therefore, the claim is limited to an apparatus with an engagement mechanism that is capable of performing the recited function. It is submitted that the Less patent does not show an apparatus which is capable of achieving this function and, therefore, does not anticipate claim 1 of the present application. Specifically, the engagement mechanisms shown in

the various embodiments shown in the Less patent are not capable of engaging the knot of a necktie. Nor is there any suggestion or motivation shown for modifying the apparatus of the Less patent to have this capability.

In addition, claim 1 requires an engagement mechanism: (1) for attaching the necktie holding apparatus to a *collar button*, (2) that is *located at the “first end”* of the necktie holding apparatus. None of the various embodiments disclosed in the Less patent meet either of these requirements. Specifically, the invention described in the Less patent is intended to be used to maintain the body of a necktie close to a user’s shirt. Thus, the device is affixed to a wearer’s shirt at a location that is distal from the knot and is, instead, roughly in the middle of the shirt. Attaching the device of the Less patent to a collar button is not suggested, and would defeat the purpose of the invention. The Less patent apparatus would not serve its intended function if it were attached to the collar button of a shirt. Furthermore, while the embodiments disclosed in the Less patent are intended to be attached to a shirt button, in every instance the button engagement structure is located in the middle of the apparatus, **not a at an end, as required by claim 1**. The hooks that are shown at the ends of the various embodiments are not suitable for attachment either to a button or to a necktie knot. Instead, these hooks (or “stitch engaging portions”) are used to attach the device to stitches on the necktie. (See, *e.g.*, column 3, line 73 – column 4, line 6.)

Claim 2 is dependent on claim 1 and additionally requires a button hole *in an enlarged area at the first end*. As noted, in the Less device, the button is positioned in the middle, not at an end.

Claims 4 and 8, which have been amended, are discussed above. To reiterate, the Less patent does not show hooks that have curvatures in orthogonal or intersecting planes. Moreover, like claim 1, claim 8 specifies that the necktie holding apparatus has an attachment structure *at a first end thereof for securing ... to the collar button of a user’s shirt.*” Again, the Less invention does not include button attachment means **at an end thereof** nor does the Less patent show or suggest attachment to a **collar button**.

As to claim 11, applicant submits that there is no suggestion or other motivation shown for constructing any of the devices of the Less patent out of a metal wire. Since the invention of the Less patent is used for an entirely different purpose and functions in a different way, it is submitted that it would be impractical to construct the invention from a wire.

As to claim 12, applicant submits that there is no suggestion or other motivation shown for constructing the invention of the Less patent out of a precious metal.

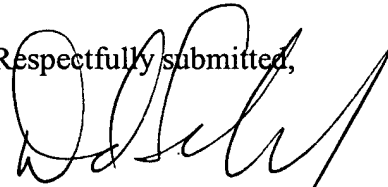
Conclusion

It is respectfully submitted that, in view of the foregoing amendments and remarks, the application is now in condition for allowance, and such action is earnestly solicited. The examiner is invited to call the undersigned, at the telephone number listed below, if doing so might advance the prosecution of this application.

October 27, 2004

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Respectfully submitted,



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